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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/820,811

04/09/2004

Edward J. Geska

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04/25/2006

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EXAMINER

PELTZER, GERARD R

ART UNIT

PAPER NUMBER

3637

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/820,811 | GESKA ET AL. | |
| | Examiner | Art Unit | |
| | Gerard Peltzer | 3637 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on ____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4/9/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In Claims 1-5, the means for attaching and securing the insulated wall system either to the concrete wall or to the floor and ceiling is not described.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 and dependent claims 2-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "An insulated wall system for a basement with interior concrete walls that is nearly adjacently disposed to the interior concrete walls" is indeterminate language as it is unclear from the sentence grammar whether an insulated wall system is claimed or an insulated wall system with interior concrete walls is claimed. The "foundation concrete walls" on line 6 of Claim 1 lacks antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Nelsson, U.S. Patent No. 3,305,993. For Claim 1, Nelsson shows an insulated wall system nearly adjacently disposed to another wall comprising a plurality of metal studs with c or u – shaped cross sections (18) forming a plurality of cavities, a plurality of insulation sections (32) frictionally fit in the plurality of cavities, and a plurality of fire retardant sheets (14) attached to the plurality of vertical studs (column 2, line 25) and holding the plurality of insulation sections within the insulated wall system. For Claim 3, Nelsson shows the use of drywall in the wall construction (column 2, line 21). For Claim 4, Nelsson shows the use of drywall screws in the wall construction (column 2, line 26).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelsson in view of Whitmarsh, U.S. Patent No. 2,116,457.

Nelsson shows an insulated wall system nearly adjacently disposed to another wall comprising a plurality of metal studs with c or u – shaped cross sections (18) forming a plurality of cavities, a plurality of insulation sections (32) frictionally fit in the plurality of cavities, and a plurality of fire retardant sheets (14) attached to the plurality of vertical studs (column 2, line 25) and holding the plurality of insulation sections within the insulated wall system. Nelsson does not show an air space between walls.

Whitmarsh teaches an air space in Figure 1 (17) for building ventilation. It would have been obvious to one of ordinary skill in the art at the time of the invention to position the wall of Nelsson with the air space of Whitmarsh to create the insulated wall system claimed for the purpose of providing an insulated wall system that does not have insulation attached to a potentially moist concrete basement wall.

For Claim 3, Nelsson discloses the use of gypsum wallboard and drywall construction in the wall construction (column 1, lines 10-24).

For Claim 4, Nelsson describes the use of mechanical rotary fasteners to secure the fire retardant sheet to the metal stud in the wall construction (column 1, line 26).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nelsson in view of Whitmarsh as applied to claims 1, 3, and 4 above, and further in view of Pichette, U.S. Patent No. 4,653,241. Nelsson, modified by Whitmarsh, shows every element of the claims mentioned except for insulation sections glued into the plurality of cavities. Pichette shows gluing of insulation to the walls in a wall cavity to be common in the art when frictionally fit products cannot perform as required (column 1, lines 38-54). It would have been obvious to one of ordinary skill in the art at the time of the

invention to use the teaching of Pichette to glue the plurality of fiberglass insulation sections of Nelsson into the plurality of cavities in order to better secure them.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nelsson in view of Whitmarsh as applied to claims 1, 3, and 4 above, and further in view of Dixon, U.S. Patent No. 5,557,898. Nelsson, modified by Whitmarsh, shows every element of the claims mentioned except for the use of pneumatic staples to attach the fire resistant sheet to the metal studs. Dixon teaches pneumatically driven nails (20) securing a planar wall member (12) to a metal stud (14). Nails are functionally equivalent to staples as known in the art, and staples are admitted as known by the applicant of the instant application (page 9, lines 12-14 of Specification). It would have been obvious to one of ordinary skill in the art at the time of the invention to secure the fire retardant sheets to the metal studs of Nelsson with pneumatic nails or staples as per the teaching of Dixon in order to utilize an inexpensive and effective common building material.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Conahey Jr., U.S. Patent No. 2,037,007 (column 1, lines 25-40), Henderson, U.S. Patent No. 2,294,556 (Figure 18), and Munro, U.S. Patent No. 2,935,865 (Figure 1, see also column 1, line 44) all teach separation of an inner wall from an outer wall by means of an air space. Bindi, U.S. Patent No. 4,653,241, shows the gluing of insulation sections and a vapor barrier to interior surface walls to be common

in the art (column 2, lines 23-26). Wingert, U.S. Patent 4,946,087, discloses staple driving tools including pneumatically driven staples.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerard Peltzer whose telephone number is (571) 272-7299. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571)272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GP *GP*

4/18/2006

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Lanna Mai